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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,523	10/30/2003	Helmut L. Kayan	2512 CON2 (203-2719CON2)	7663
Paul R. Audet United States Surgical, a Division of Tyco Healthcare Group LP 150 Glover Avenue Norwalk, CT 06856			EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 06/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/697,523

**Applicant(s)**

KAYAN ET AL.

**Examiner**

Michelle Lopez

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 2/2/04  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 1-29, in the reply filed on 5/5/08 is acknowledged. The traversal is on the ground(s) that there is not a serious burden on the Examiner if restriction were no required, since the fields of search are believed to be co-extensive for the two groups. This is not found persuasive because the inventions have a separate status in the art due to their recognized divergent subject matter.

Claim 20 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/5/08.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 2/2/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. The abstract of the disclosure is objected to because it has more than 150 words.

Correction is required. See MPEP § 608.01(b).

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recesses in the handle portion as set forth in claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***DOUBLE PATENTING REJECTION***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 5, 7, and 9-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4-15 of U.S. Patent No. (6,228,098).

Although the conflicting claims are not identical, they are not patentably distinct from each other because a person having ordinary skill in the art would have found the claims of the instant application to be obvious variations of the claims of the patents. The claims of the

patents and the claims of the present application are both directed to the same subject matter of a fastening apparatus for use in endoscopic surgery comprising a handle, a triggering mechanism, a fastener applicator, and an anvil. While the claims of the present application and the claims of the patents may have variations and differences in their scope and terminology, the variations and differences would have been obvious to one having ordinary skill in the art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 11-14, and 16-29 are rejected under 35 U.S.C. 102(b) as being anticipated by McGarry et al. (5,366,479). McGarry discloses a fastening apparatus for use in endoscopic surgery comprising a handle portion (18), a triggering mechanism (20), a fastener applicator (16) comprising a shaping slide (104) having a cooperating notch at the vicinity of (104R, 104L), and an anvil via (116, 118). The fastener applicator is deemed to be detachable from the handle via connection (89) as shown in fig. 15. The applicator (16) comprises two cooperating half shells (16a, 16b) containing a storage channel and a driving channel (see figs. 16-21), and a slide actuator (104). The storage and driving channels are parallel (see figs. 15-16). The applicator has a plurality of leaf springs (124, 113). Movement of a slide via (102) controls the location of spring (124) as shown in figs. 23 and 25. Spring (113) is deemed to be a fastener stop spring and spring (124) is an ejector spring. Movement of (102,104) controls the opening of the storage

channel as shown in fig. 16. The applicator comprises actuated parts (102,104) which move together linearly. A plunger assembly having a ratchet (52), a pawl (58), and spring via (60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarry et al. (5,366,479) in view of Taylor (4,619,262). McGarry shows the shaping slide (104) having a notch cooperating with an anvil to attach a fastener to body tissue, but fail to disclose wherein said anvil is angled so as to receive an anvil with a triangular cross-section. Taylor teaches the concept of surgical stapling device having a slide (12) with a notch at the vicinity of (13') being angled to closely match and receive an anvil (20b) having an essentially triangular cross-section to properly bend the legs of a fastener as shown in fig. 7. It would have been obvious to one having ordinary skill in the art to have provided McGarry's slide notch and anvil with a triangular cross-section as taught by Taylor in order to bend the legs of a fastener.

With respect to claims 3 and 5-8, Taylor also discloses wherein the notch is angled to closely receive a rounded-edge cross-section of an anvil as shown in fig. 6. Taylor's anvil has a single faster forming point.

With respect to claims 9-10, McGarry also discloses a plurality of stacked fasteners (110). The applicator (16) is deemed to be separable form the handle via connection (89) as shown in fig. 15.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarry et al. (5,366,479) in view of Taylor (4,619,262), as applied to claims 11 and 14 above, and further in view of Hucil et al. (4,043,504).

The modified invention of McGarry discloses surgical fastenning apparatus with a slide actuator (104), but fails to disclose wherein the slide actuator is lockable by engagement of a pin that alternately engages and disengages the slide actuator. Hucil shows a surgical device comprising a handle (12), a slide actuator (25), and a locking pin (29) which alternately engages and disengages the slide actuator via (25a) for the purposes of preventing inadvertently forward movement of said actuator. It would have been obvious to one having ordinary skill in the art to have provided the modified invention of McGarry further having a locking pin as taught by Hucil in order to prevent movement of the slide actuator.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ML/  
Patent Examiner

/Rinaldi I Rada/  
Supervisory Patent Examiner, Art Unit 3721